

REMARKS

Claims 1-66 have been allowed. Claims 67-86 have been canceled by examiner's amendment, pursuant to a phone conversation confirmed herein.

Summary of Interviews

September 15, 2004 Phone Conversation

Pursuant to MPEP 713.04, and labeled according to the letters therein, the Applicants summarize a September 15, 2004 examiner-initiated telephone call:

- (A) no exhibit was shown
- (B) claims 67-86 were discussed
- (C) no references were discussed
- (D) the cancellation of claims 67-86 was discussed
- (E) The examiner suggested that claims 67-86, which are dependent product claims, should not be allowed at the same time as claims 1-66, which are method claims, due to the difference in claim format (product vs. method). The examiner suggested cancellation of claims 67-86 by examiner's amendment. The Applicants argued that such cancellation was not necessary, and proposed amendment of the claims into method form. However, the examiner raised the point that such amendment was somewhat involved for an examiner's amendment. The Applicant agreed to the suggested cancellation of dependent claims in order to expedite prosecution.
- (F) No comment
- (G) Agreement was reached regarding cancellation of claims 67 - 86 by examiner's amendment
- (H) There was no e-mail communication between Applicants and the PTO.

September 29 Phone Conversation

Pursuant to MPEP 713.04, and labeled according to the letters therein, the Applicants summarize a September 29, 2004 applicant-initiated telephone call:

- (A) no exhibit was shown
- (B) no claims were specifically discussed
- (C) Kim et al, "Micropatterning of Organic Electronic Devices by Cold-Welding," Science vol. 288, p. 831-833, 5 May 2000 was discussed.
- (D) no claim amendments were discussed

- (E) The Applicant reminded the examiner that:
- (1) US Patent No. 6,294,398 to Kim et al. played a prominent role in the most recent rejection;
 - (2) Kim '398 was removed as prior art by a statement of common ownership, and the examiner's "Reasons for Allowance" indicates that this removal was the reason for allowance;
 - (3) there are similarities between the disclosures of the '398 patent and the Kim paper discussed in (C) above, which was disclosed by the Applicant on a PTO 1449 submitted on June 25, 2001 and considered and initialed by the examiner on May 10, 2004.

The Applicant requested specific consideration of the Kim paper, and a supplemental "Reasons for Allowance" reflecting such consideration.

- (F) The examiner was able to view the file history in the USPTO electronic database, but a copy of the PTO 1449 citing the Science paper by Kim discussed in (C) above was not scanned into the proper place (the June 25, 2001 IDS was present, but not the attached PTO 1449). The Applicant agreed to fax to the examiner at 703-746-9227 a copy of the PTO 1449 and the Kim paper. The Applicant also faxed a courtesy copy of this "Comments on Statement of Reasons for Allowance."
- (G) The examiner agreed to present the Kim paper and the PTO 1449 to his supervisor, and determine whether any further action is needed in this application, specifically whether prosecution needs to be re-opened, whether a Supplemental Reasons for Allowance is appropriate, or whether the record (which includes the PTO 1449 initialed on May 10, 2004 and this Comments on Statement of Reasons for Allowance) accurately reflects complete consideration of all relevant references.
- (H) There was no e-mail communication between Applicants and the PTO.

The Applicants respectfully assert that the claims are patentable over a combination of the Kim paper and Whitesides for reasons discussed at the June 18, 2004 interview and summarized on page 7, letter (E) of the June 28, 2004 Response to Office Action.

Since the Kim paper was disclosed by the Applicant on June 25, 2001, the Applicants respectfully assert that there is no obligation on the part of the Applicants to file an RCE in order to have the Kim paper considered, and that the examiner has an obligation to fully


Serial No.: 09/833,695

consider this reference if he has not already done so. See also, "Comment re: Finality of Rejection" on page 7 of the June 28, 2004 Response to Office Action.

CONCLUSION

The Commissioner is authorized to charge any fees relevant to this filing to Kenyon & Kenyon Deposit Account 11-0600. The Examiner is invited to contact John McGroarty at (202) 220-4227 to discuss any matter concerning this application.

Respectfully submitted,



John McGroarty
Registration No. 41,186

DATE: September 29, 2004

KENYON & KENYON
1500 K Street, N.W., Suite 700
Washington, D.C. 20005-1257
(202) 220-4200 (Tel)
(202) 220-4201 (Fax)

DC01 477822 v 1